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Application Number	09/420,692
Filing Date	October 19, 1999
First Named Inventor	BESTERMAN
Art Unit	1635
Examiner Name	Zara, Jane J.
Total Number of Pages in This Submission: 3	Attorney Docket Number: MET-015US1 (1002/016

ENCLOSURES (*Check all that apply*)

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☑ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
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- ☐ Drawing(s)
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Remarks

1. Post Card

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	9/21/04

CERTIFICATE OF MAILING

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	**Besterman**
Serial No.:	**09/420,692**
Filed:	**October 19, 1999**
Entitled:	**MODULATION OF GENE EXPRESSION BY COMBINATION THERAPY**
Examiner:	**Zara, Jane J.**
Group Art Unit:	**1635**
Attorney Docket No.:	**MET-015US1 (1002/016)**

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RESPONSE TO FINAL OFFICE ACTION

Sir:

In response to the Final Office Action dated August 24, 2004, please consider the following remarks.

Claims 1-3, 6 and 13 are pending in the application. All claims are rejected as not satisfying the written description and enablement requirements. However, these rejections are contrary to both Federal circuit precedent and PTO policy as stated in the M.P.E.P.

As to other oligonucleotides and protein inhibitors, undoubtedly some screening using the method of Example 6 would be required. However, these experiments, which would require no modification of the method of Example 6, would not be undue. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *Massachusetts Institute of Technology v. A.B. Fortia*, 227 U.S.P.Q. 428 (Fed. Cir. 1985) See also M.P.E.P. §2164.01. In the antisense and protein inhibitors fields, scientists typically engage in such screening, and would have to do so no matter how many oligonucleotides or protein inhibitors are exemplified. In addition, the enablement requirement is met if the description enables any mode of making and using the invention. *Johns Hopkins*

University v. Cell Pro Inc., 47 U.S.P.Q.2d 1705, 1718 (Fed. Cir. 1998), *citing Engel Indus., Inc. v. Lockformer Co.*, 20 U.S.P.Q.2d 1300, 1304 (Fed. Cir. 1991). Applicant has clearly met this requirement.

Applicants' invention is not a particular antisense oligonucleotide or a particular DNA MTase protein inhibitor. Rather, it is the discovery that inhibition of DNA MTase gene expression and protein inhibition is synergistic. Accordingly, the rejection of the pending claims for lack of written description and non-enablement was in error.

In view of this precedent and policy, Applicants respectfully request reconsideration of the presently maintained rejections.

Respectfully submitted,

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